

REMARKS

Claims 1-6, 9-15, 18, and 77-82 were pending in the patent application at the time the final Office Action was mailed. Claims 1, 79, and 81 are amended by this response. Claim 83 is added by this response and no claims are canceled by this response. Accordingly, claims 1-6, 9-15, 18, and 77-83 are pending.

The Office Action rejected claims 1-6, 9-15, 18, and 77-82 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent No. 6,662,212 ("Chandhok") in view of U.S. Patent No. 6,463,461 ("Hanson"). Applicant respectfully traverses these rejections and requests reconsideration of the pending claims in light of the following remarks.

The following remarks describe the applied references and then analyze differences between applicants' technology and the applied references.

A. Chandhok

Chandhok teaches a technique for "synchronizing files shared by members of a distributed workgroup through electronic mail." (Chandhok, Abstract.) According to this technique, "[e]lectronic mail having a synchronization command embedded in multipurpose internet mail extensions is generated when a workgroup member revises a workgroup file and is sent to the other workgroup members. Upon receipt of the electronic mail containing the synchronization command, the local copy of the corresponding workgroup file resident on the computer of the recipient is synchronized to reflect the revision." (Id.)

B. Hanson

Hanson teaches a technique for "communicating information among a group of participants." (Hanson, title.) In this technique, electronic media for communicating information, which is referred to in Hanson as a "zaplet" (Hanson, 4:25-28), is stored in a

database in a server. (Hanson, 4:38-39.) The server is "configured to manage the dynamic content, routing, and updating of electronic forms, messages, or zaplets among the participants." (Hanson, 6:6-8.) The "server" referred to in various discussions in Hanson comprises multiple conventional components, such as an electronic mail server, web server, database server, and so forth. (See Hanson, Figure 2 and accompanying discussion beginning at 6:45.)

In Hanson's technique, the "web application server 14 is responsible for executing business logic associated with the electronic forms, messages, and zaplets. For example, the web application server 14 may manage message, form, and zaplet manipulation, ... and participant interaction with various zaplets, forms, and messages." (Hanson, 6:65-7:6.)

Hanson's technique employs email and non-email components to enable collaboration. (Hanson, 9:21-59 and 10:1-18.) In Hanson's technique, a collaborative message is an electronic mail ("email") message with an embedded web form. (See, e.g., Hanson, 9:5-67.) Various functions of Hanson's technique are provided by using a web server and an email server. (See, e.g., Hanson, 11:12-43.) For example, to begin collaborating, a participant requests a web form from a web server, completes fields in the web form, and submits the web form to the web server. (Hanson, 11:12-22.) The technique then utilizes an email server to send email to the participants with an indication of the collaboration message. (Hanson, 11:32-35.) When a recipient opens the email message, the web content is served by a web server and displayed to the recipient. (Hanson, 11:40-65.) To update the collaboration (e.g., to respond to a collaboration message), the recipient adds information to the web form and submits the web form to the web server. (See Hanson, 2:4-24.)

Thus, in Hanson's technique, users interact with web servers to create and manipulate collaborative messages and the web server interacts with an email server to send notifications.

C. Applicants' Technology

Applicants' technology is directed to a collaborative email system in which collaborative electronic mail messages are fully integrated into conventional electronic mail systems. For example, "each time a user creates a new collaborative email message, views a collaborative email message, responds to a collaborative email message, etc., the user selects the actions to be taken by interacting with his or her email system." (Applicants' specification, 12:2-5.)

The user may indicate various actions relating to the collaborative email message, such as encrypting, marking as special, etc. "Any such actions taken by the author are identified in the collaborative email message and may be enforced by the email servers or the clients." (Applicants' specification, 22:6-8.)

After the recipient of the collaborative email message takes collaborative steps, such as by adding comments, the recipient sends the message. (Applicants specification, 32:17-21.) The collaborative email message is then forwarded to an email server.

In various embodiments of applicants' technology, email servers manage collaborative email messages and conventional email messages. (See applicants' specification, 34:20-22.) The email server modifies collaborative email messages in accordance with commands it receives. Various examples of modifying collaborative email messages are provided in applicants' specification, such as "if the user has entered new comments/feedback in the response, then email server 266 copies those comments/feedback into its stored copy of the collaborative email message"; and "if the user has entered a response to a poll, then this response is detected by the email server and updated in the stored copy of the collaborative email message so that a running tally of responses... can be updated." (Applicants' specification, 37:9-19.)

Thus, in applicants' technique, users interact with an email system to create and manipulate collaborative email messages. (See also applicants' Figure 9 and its accompanying text beginning at 36:7.)

D. Analysis

1. No *Prima Facie* Rejection

The Office Action combines Chandhok and Hanson to reject the pending claims. (See Office Action, Page 2.) In rejecting the pending claims, the Office Action merely indicates that Chandhok teaches all pending claims "through Hanson." (See, e.g., Office Action, Pages 2, 4, 5, and so forth.) However, the Office Action fails to indicate how Chandhok and Hanson are to be combined. As an example, it fails to indicate what features of the claims are lacking in Chandhok for which it relies on Hanson, or vice versa. Contrary to the requirements of MPEP § 706.02(j), the Office Action fails to set forth (1) the differences in the claims over the applied references and (2) the proposed modifications to the applied references necessary to arrive at the claimed subject matter. Because the Office Action has not met its initial burden of establishing obviousness, it has not made a *prima facie* rejection of the pending claims. (MPEP § 706.02(j).) Moreover, 35 U.S.C. § 132 "is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection."¹ *Chester v. Miller*, 906 F.2d 1574, 1578, (Fed. Cir. 1990).

2. The Applied References Neither Teach Nor Suggest Modifying Collaborative Email Messages at an Email Server

Even if the Office Action has made a *prima facie* case for obviousness, the applied references, either alone or when combined, do neither teach nor suggest modifying a collaborative email message at an email server. Claim 1 recites "sending to the electronic

¹ "Whenever, on examination, any claim for a patent is rejected, . . . the Director shall . . . stat[e] the reasons for such rejection, or objection. . . ." 35 U.S.C. § 132(a) (1988).

mail server an indication of the command so that the electronic mail server can modify the collaborative electronic mail message in accordance with the command and notify recipients of the modification." Claim 79 recites "modifying the collaborative electronic mail message in accordance with the command and notifying recipients of the modification." Claim 81 has been amended to recite "modifies the electronic mail message and takes an appropriate action for the received command when the electronic mail message is a collaborative electronic mail message." The Office Action apparently cites Chandhok at 2:34-53, 3:10-19 and 4:16-26 as teaching this feature. At 2:34-53, Chandhok teaches standard mail server functionality combined with Chandhok's mail user agent installed on client computers that determines whether each incoming email message contains a file synchronization command. At 3:10-19, Chandhok teaches sending file synchronization commands in an email message. At 4:16-26, Chandhok teaches synchronizing files when commands are contained in an email message and disregarding the email if the recipient of the email is not a member of a workgroup. There is no teaching or suggestion in the cited portions of Chandhok that an email server modifies a collaborative email message. Applicants are unable to find any such teaching or suggestion in either Chandhok or Hanson.

3. Combining Chandhok and Hanson Would Not Result in Applicants' Invention

Combining Chandhok and Hanson would result in an HTML-based collaborative system in which synchronization commands are embedded in collaborative email messages and shared between email clients to synchronize files. The combination would not modify a collaborative email message at an email server that handles conventional and collaborative email messages.

Chandhok teaches sending in an email message synchronization commands from one email client to another email client using a conventional email server that does not modify the email message. According to the Office Action, "[w]orkgroup shared files are collaborative files (sic)." (Office Action, Page 2.) As was discussed above, applicants'

technology works with collaborative email messages. A collaborative email message "is an email message that can include input from multiple different users and that arranges the input in a user-friendly manner." (Applicants' specification, 5:20-21.) In contrast, Chandhok discusses synchronization of shared files. The Office Action points to Chandhok at 2:49-53 and 4:16-26 for the proposition that Chandhok's shared file is equivalent to applicants' collaborative email message. (Office Action, Page 2.) At 2:49-53, Chandhok teaches sending messages via email to multiple recipients containing synchronization commands that are employed to keep the system synchronized. Examples of commands are provided at 6:30-65, such as Add, Update, and Delete. When a recipient receives these commands, it adds, updates, or deletes synchronized files that are stored locally. At 4:16-26, Chandhok teaches synchronizing files when commands are contained in an email message and disregarding the email if the recipient of the email is not a member of a workgroup. There is no indication in the cited sections that a file (or an email containing a synchronization command) is similar to a collaborative email message, and applicants can find no such teaching or suggestion in Chandhok.

Hanson teaches using an HTML-based system with an email system to provide collaborative email messages. Applicants can find no teaching or suggestion in Hanson for modifying a collaborative email message at an email server that handles conventional and collaborative email messages.

Thus, combining Chandhok and Hanson does not result in a collaborative email system that modifies collaborative email messages at an email server that handles conventional and collaborative email messages.

E. Added Independent Claim 83

Applicants have added independent claim 83. Support for this claim is found in applicants' Figure 12 and corresponding detailed description at 46:23-48:19. As recited by claim 83, applicants' technology can communicate a collaborative email message to

multiple recipient email servers (e.g., from a "home server"), receive a response to the collaborative email message from one of the recipient email servers, modify the collaborative email message at the home server, and then communicate the modified collaborative email message to recipient email servers. In contrast, the conventional email servers employed by Chandhok and Hanson would broadcast responses to all email servers, including the home server and the other recipient servers. Applicants can find no teaching or suggestion of the features recited in claim 83 in the applied references.


F. Conclusion

Because the applied references neither teach nor suggest the features discussed above, the independent claims cannot be rejected under 35 U.S.C. § 103(a). Because the dependent claims import the limitations from the claims on which they depend, they also cannot be rejected under 35 U.S.C. § 103(a). Moreover, the claims recite a novel combination of elements that is neither taught nor suggested by the applied references.

Based on the above amendments and remarks, applicants respectfully request reconsideration of this application and its early allowance. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-6478.

Respectfully submitted,
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